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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,667	11/15/2001	Naruto Entani	Q67321	7510

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SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER
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CHANDLER, SARA M

ART UNIT	PAPER NUMBER
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3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/987,667	<b>Applicant(s)</b> ENTANI, NARUTO	
	<b>Examiner</b> Sara Chandler	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/15/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 09/987,667 (11/15/2001) filed on 01/30/07.

### ***Preliminary Matters***

Acknowledgement of the 35 USC 119 priority documents and the drawings can be found on the Office Action Summary attached to this Office Action.

Examiner disagrees with applicant's assertion that a concise explanation of the references cited in the IDS filed 06/07/04 has been provided either separate from applicant's specification or incorporated therein. Thus, the IDS filed 06/07/04 has not been considered. See 37 CFR 1.97, 1.98 and MPEP § 609.

### ***Claim Objections***

Claims 12,13 and 14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim. See MPEP §608.01(n), Section III.

The dependent claims 12,13 and 14 recite:

Re Claim 12: A system according to claim 1, wherein the request information includes information indicating a restrictive area where an information requester at said information requester terminal can buy the commodity, and said management server supplies said information requester terminal with only pieces of selling price information of stores located in the restrictive area.

Re Claim 13: A system according to claim 1, wherein said management server supplies said information requester terminal with part of the collected selling price information

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that excludes information about stores before supplying the collected selling price information to said information requester terminal.

Re Claim 14: A system according to claim 1, wherein said management server performs processing for paying a prescribed informer fee to only part of said information provider terminals that provided pieces of selling price information with some ones of a lowest selling price and prices close to it after selling the collected selling price information to said information requester terminal.

Applying the infringement test, what is needed to infringe claims 12,13 and 14, for example is a system for applying the steps of claim 1. However, the system, would **not** infringe the method steps of claim 1 since the system itself never performs any of the active steps of receiving, collecting, supplying or performing required by the method. In other words, mere possession of such a system would infringe claims 12,13 and 14, respectively, but this is not enough to infringe claim 1. As a result, claims 12,13 and 14 are improper dependent claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1, 5-8 and 12-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Grdina, US Pat. No. 6,965,872 in view of Aarnio, US Pub. No. 2004/0078274.

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**Re Claims 1:** Grdina discloses a method comprising the steps of:

receiving, from an information requester terminal, an information request that requests selling price information about a commodity, and communicating the information request to a plurality of information provider terminals (Grdina, abstract; col. 3, lines 4-28; col. 3, lines 29-46; col. 6, lines 22-30);

collecting pieces of selling price information that are received from part of said plurality of information provider terminals in response to the information request and match the information request, and generating collected selling price information that matches the information request (Grdina, abstract; col. 3, lines 29-46; col. 6, lines 22-30);

supplying the collected selling price information to said information requester terminal (Grdina, abstract; col. 3, lines 29-46; col. 6, lines 22-30; col. 7, lines 25-28; );

and performing processing for paying a prescribed informer fee to the part of said plurality of information provider terminals that provided the pieces of selling price information that match the information request (Grdina, abstract, Figs. 2,5,12; col. 8, lines 9-13; col. 8, lines 42-50; col. 12, lines 15-20; col. 12, lines 45-50).

Grdina fails to explicitly disclose a method comprising the step of:

charging said information requester terminal a prescribed information supply fee and mediation commission.

Aarnio discloses a method comprising the step of:

charging said information requester terminal a prescribed information supply fee and mediation commission (Aarnio, abstract, Fig. 3; [0023]).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Grdina by adopting the teachings of Aarnio to provide a selling price information mediation service method for mediating and supplying, selling price information which includes selling prices of a commodity in respective stores and information about the respective stores, over a network, the method comprising: receiving, from an information requester terminal, an information request that requests selling price information about a commodity, and communicating the information request to a plurality of information provider terminals; collecting pieces of selling price information that are received from part of said plurality of information provider terminals in response to the information request and match the information request, and generating collected selling price information that matches the information request; supplying the collected selling price information to said information requester terminal, and charging said information requester terminal a prescribed information supply fee and mediation commission; and performing processing for paying a prescribed informer fee to the part of said plurality of information provider terminals that provided the pieces of selling price information that match the information request.

As suggested by Aarnio, one would have been motivated by profit to allow payment for services provided.

**Re Claim 8:** Grdina discloses a system comprising:

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at least one information requester terminal which requests selling price information

(Grdina, abstract, Figs. 1-16; col. 1, line 1+ - col. 18, line 13);

a plurality of information provider terminals, each of which provide selling price

information for a retailer (Grdina, abstract, Figs. 1-16; col. 1, line 1+ - col. 18, line 13);

and

a management server which mediates selling price information (Grdina, abstract, Fig. 1,

col. 6, line 20 – col. 7, line 19);

wherein the mediating selling price information comprises (Grdina, abstract, Figs. 1-16; col. 1, line 1+ - col. 18, line 13; “wherein” as used here is not further limiting. It fails to limit the system claim to a particular structure. See MPEP § 2106 II C):

receiving, from an information requester terminal, an information request that requests selling price information about a commodity, and communicating the information request to a plurality of information provider terminals (Grdina, abstract; col. 3, lines 4-28; col. 3, lines 29-46; col. 6, lines 22-30);

collecting pieces of selling price information that are received from part of said plurality of information provider terminals in response to the information request and match the information request, and generating collected selling price information that matches the information request (Grdina, abstract; col. 3, lines 29-46; col. 6, lines 22-30);

supplying the collected selling price information to said information requester terminal (Grdina, abstract; col. 3, lines 29-46; col. 6, lines 22-30; col. 7, lines 25-28; );

and performing processing for paying a prescribed informer fee to the part of said plurality of information provider terminals that provided the pieces of selling price

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information that match the information request (Grdina, abstract, Figs. 2,5,12; col. 8, lines 9-13; col. 8, lines 42-50; col. 12, lines 15-20; col. 12, lines 45-50).

Grdina fails to explicitly disclose a system comprising:  
charging said information requester terminal a prescribed information supply fee and mediation commission.

Aarnio discloses a system comprising:  
charging said information requester terminal a prescribed information supply fee and mediation commission (Aarnio, abstract, Fig. 3; [0023]).

Intended Use: The claims make several intended use statements which do not carry patentable weight (e.g., "system for"; "a management server for"; "processing unit which performs processing for"). What follows the statement of intended use (i.e., "for") does not carry patentable weight. The claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Grdina by adopting the teachings of Aarnio to provide a system for mediating and providing selling price information over a network, the system comprising:  
at least one information requester terminal which requests selling price information;  
a plurality of information provider terminals, each of which provide selling price information for a retailer; and



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a management server which mediates selling price information;

wherein the mediating Selling price information comprises:

receiving, from an information requester terminal, an information request that requests selling price information about a commodity, and communicating the information request to a plurality of information provider terminals;

collecting pieces of selling price information that are received from part of said plurality of information provider terminals in response to the information request and match the information request, and generating collected selling price information that matches the information request;

supplying the collected selling price information to said information requester terminal, and charging said information requester terminal a prescribed information supply fee and mediation commission;

and performing processing for paying a prescribed informer fee to the part of said plurality of information provider terminals that provided the pieces of selling price information that match the information request.

As suggested by Aarnio, one would have been motivated by profit to allow payment for services provided.

**Re Claim 15:** Grdina discloses a management server comprising:

a receiving unit which receives an information request which requests selling price information about a commodity from at least one information requester terminal (Grdina, abstract; Figs. 1-16; col. 3, lines 4-28; col. 3, lines 29-46; col. 6, lines 22-30),

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a communication unit which communicates the information request to a plurality of information provider terminals (Grdina, abstract; Figs. 1-16; col. 3, lines 4-28; col. 3, lines 29-46; col. 6, lines 22-30);

a collecting unit which collects pieces of selling price information that are received from part of said plurality of information provider terminals and match the information request, and generates collected selling price information that matches the information request (Grdina, abstract; Figs. 1-16; col. 3, lines 29-46; col. 6, lines 22-30);

a supplying unit which supplies the collected selling price information to said information requester terminal (Grdina, abstract; col. 3, lines 29-46; col. 6, lines 22-30; col. 7, lines 25-28; ); and

a processing unit which performs processing for paying a prescribed informer fee to the part of said plurality of information provider terminals that provided the pieces of selling price information that match the information request (Grdina, abstract, Figs. 2,5,12; col. 8, lines 9-13; col. 8, lines 42-50; col. 12, lines 15-20; col. 12, lines 45-50).

Grdina fails to explicitly disclose a system wherein the supplying unit charges said information requester terminal a prescribed information supply fee and mediation commission.

Aarnio discloses a system wherein the supplying unit charges said information requester terminal a prescribed information supply fee and mediation commission (Aarnio, abstract, Fig. 3; [0023]).

Intended Use: The claims make several intended use statements which do not carry patentable weight (e.g., "system for"; "a management server for"; " processing unit

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which performs processing for"). What follows the statement of intended use (i.e., "for") does not carry patentable weight. The claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Grdina by adopting the teachings of Aarnio to provide a management server for mediating selling price information over a network, the management server comprising:

a receiving unit which receives an information request which requests selling price information about a commodity from at least one information requester terminal, a communication unit which communicates the information request to a plurality of information provider terminals;

a collecting unit which collects pieces of selling price information that are received from part of said plurality of information provider terminals and match the information request, and generates collected selling price information that matches the information request;

a supplying unit which supplies the collected selling price information to said information requester terminal and charges said information requester terminal a prescribed information supply fee and mediation commission; and

a processing unit which performs processing for paying a prescribed informer fee to the part of said plurality of information provider terminals that provided the pieces of selling price information that match the information request.

As suggested by Aarnio, one would have been motivated by profit to allow payment for services provided.

**Re Claims 5 and 12:** Grdina in view of Aarnio discloses the claimed method/system supra and Grdina further discloses wherein the request information includes information indicating a restrictive area where an information requester at said information requester terminal can buy the commodity, further comprising the step of supplying said information requester terminal with only pieces of selling price information of stores located in the restrictive area (Grdina, abstract; col. 1, lines 24-27; col. 3, lines 4-11; col. 3, lines 42-46; col. 6, lines 22-30; col. 7, lines 25-28).

**Re Claims 6 and 13:** Grdina in view of Aarnio discloses the claimed method/system supra and Grdina further discloses supplying said information requester terminal with part of the collected selling price information that excludes information about stores before supplying the collected selling price information to said information requester terminal (Grdina, abstract; col. 3, lines 29-46; col. 6, lines 22-30; col. 7, lines 25-28; ).

**Re Claims 7 and 14:** Grdina in view of Aarnio discloses the claimed method/system supra and Grdina further discloses performing processing for paying a prescribed informer fee to only part of said information provider terminals that provided pieces of selling price information with some ones of a lowest selling price and prices close to it after selling the collected selling price information to said information requester terminal (Grdina, abstract, Figs. 2,5,12; col. 8, lines 9-13; col. 8, lines 42-50; col. 12, lines 15-20; col. 12, lines 45-50).

**Claims 2,3,9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Grdina and Aarnio as applied to claims 1 and 8 above, and further in view of Mandler, US Pat. No. 6,785,661.

**Re Claims 2 and 9:** Grdina in view of Aarnio discloses the claimed method/system supra and Grdina further discloses registering an information requester at said information requester terminal and information providers at said information provider terminals as members after causing them to clarify their identities (Grdina, abstract, Figs. 2,5,12; col. 8, lines 9-13; col. 8, lines 42-50; col. 12, lines 15-20; col. 12, lines 45-50).

Grdina fails to explicitly disclose identifying a person who has caused a problem by distributing erroneous information upon occurrence of the problem.

Mandler discloses identifying a person who has caused a problem by distributing erroneous information upon occurrence of the problem (Mandler, Figs. 1A, 1B, 2 col. 1, lines 27-65; col. 8, lines 4-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Grdina and Aarnio by adopting the teachings of Mandler to provide a selling price information mediation service method, wherein a selling price information mediating service employs a membership system, and said management server further comprises the steps of: registering an information requester at said information requester terminal and information providers at said information provider terminals as members after causing them to clarify their identities;

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and identifying a person who has caused a problem by distributing erroneous information upon occurrence of the problem.

As suggested by Mandler, one would have be motivated to accommodate users (e.g., information requestors, information providers, buyers, sellers etc. ) that may be unfamiliar with one another in a transaction for purposes such as credit requirements, the ability effect a purchase and prior acts of nonperformance.

**Re Claims 3 and 10:** Grdina in view of Aarnio discloses the claimed method/system supra but fails to explicitly disclose keeping a history of an information provider who caused a problem and disclosing the history to said information requester terminal. Mandler discloses keeping a history of an information provider who caused a problem and disclosing the history to said information requester terminal (Mandler, Figs. 1A, 1B, 2 col. 1, lines 27-65; col. 8, lines 4-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings Grdina and Aarnio by adopting the teachings of Mandler to provide a selling price information mediation service method, wherein said management server further comprises the step of keeping a history of an information provider who caused a problem and disclosing the history to said information requester terminal. As suggested by Mandler, one would have be motivated to accommodate users (e.g., information requestors, information providers, buyers, sellers etc. ) that may be unfamiliar with one another in a transaction for purposes such as credit requirements, the ability effect a purchase and prior acts of nonperformance.

**Claims 4 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Grdina and Aarnio as applied to claims 1 and 8 above, and further in view of Luke, US Pat. No. 6,131,087.

**Re Claim 4:** Grdina in view of Aarnio discloses the claimed method/supra but fails to explicitly disclose wherein the request information includes information of a limit selling price of the commodity, and further comprising supplying said information requester terminal with only pieces of selling price information With selling prices each of that is at most the limit selling price. Luke discloses wherein the request information includes information of a limit selling price of the commodity, and further comprising supplying said information requester terminal with only pieces of selling price information with selling prices each of that is at most the limit selling price (Luke, Fig. 1a; abstract; col. 5, lines 53+ - col. 6, line 11; col. 6, line 56+ - col. 7, line 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Grdina and Aarnio by adopting the teachings of Luke to provide wherein the request information includes information of a limit selling price of the commodity, and further comprising supplying said information requester terminal with only pieces of selling price information With selling prices each of that is at most the limit selling price. As suggested by Luke, one would have been motivated to make the shopping experience more efficient by making buyers, and consumers aware of discount pricing possibilities and options within their range.

***Response to Arguments***

Applicant's arguments filed 02/09/07 have been fully considered but they are not persuasive.

A network, such as the one claimed in the instant application and the in Grdina, is two or more computers connected together using a telecommunications system for the purpose of communicating and sharing resources. These computers are equivalent to the "terminals" in the claimed invention. The consumer in Gridina is using a computer or "information requestor terminal" and the retailers are at a "plurality of information provider terminals." See MPEP § 2111.

A couple definitions for a database include: a collection of records or information which is stored in a structured way so that a computer program can consult it to answer queries; and a collection of data arranged for convenient access, and speed of search and retrieval. In Gridina, the consumer is placing an "information request" regarding information such as the selling price for goods and services. The information regarding selling prices is collected from at least a part of the of the retailers and their respective "plurality of information terminals." See MPEP § 2111.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 3/5/18  
JAGDISH N. PATEL  
PRIMARY EXAMINER